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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/508,490 03/10/00 BODE

R 20496-248

EXAMINER

IM52/0215

PROSKAUER ROSE  
1585 BROADWAY  
NEW YORK NY 10036

COMBS, J

ART UNIT

PAPER NUMBER

1742

DATE MAILED:

02/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/508,490

Applicant(s)

BODE ET AL.

Examiner

Janelle Combs-Morillo

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The present specification on page 3 lines 7-8 and page 6 line 3 refers to performing the presently claimed process on an aging sensitive steel. Alternatively, claim 1 line 3 and claim 3 line 3 refer to performing the presently claimed process on a “non-aging steel”, which renders the claim indefinite. Steel alloys are characterized by either non-aging or sensitive to aging.

Claim 1 lines 2-3 refers to a “dressed strip”, which renders the claim indefinite. Claim 1 line 2 and 9, claim 3 lines 2 and 10 refer to the phrase “stove finished”, which renders the claims indefinite. The examiner asserts that these terms are not known to one of ordinary skill in the art, nor defined in the specification in a distinct manner. Clarification is needed.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. In the present instance, claim 1 lines 3-4 and claim 3 lines 3-4 recite the broad recitation “high bake-hardening potential”, and the claims further recite “more particularly of more than 70 N/mm<sup>2</sup>”, which is the narrower statement of the range/limitation. The examiner suggests changing “high bake-

Art Unit: 1742

hardening potential, more particularly of more than 70 N/mm<sup>2</sup> to “a bake-hardening of 70 N/mm<sup>2</sup> or more”.

In claim 3 lines 2-3 a cold strip is defined as “cold rolled and dressed”, yet line 5 of claim 3 states that “the cold strip is stored undressed”. Clarification is needed.

Claims dependent on the above rejected claims are likewise rejected under this statute. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson.

Stevenson teaches a process for making a steel strip with improved formability (column 7 line 10) comprising the steps of: hot or cold rolling (including temper rolling) (column 3 lines 40-41, 45), cooling to a temperature below room temperature (abstract), and forming (abstract), as presently claimed in claim 1. Stevenson also teaches that a steel strip can be retained at room temperature for about a week prior to forming (column 4 lines 35-42), as presently claimed in claim 3.

Stevenson does not teach the bake hardenability of the steel strip that has been processed according to the present invention. However, the examiner asserts that because Stevenson teaches substantially the same method as presently claimed, substantially the same results (such

Art Unit: 1742

as bake hardening) would occur. It is held that Stevenson has created a prima facie case of obviousness of the presently claimed invention.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaoka et al.

Nakaoka et al teaches a process for producing a non-aging steel sheet with high formability at the forming stage, and high hardness at the coat-baking stage (column 2 lines 7-12). Said process comprises the steps of holding the steel strip at room temperature (column 8 line 27, column 12 line 17), temper rolling, and coat baking such that the bake hardenability is  $\sim 11.1 \text{ kg/mm}^2$  ( $109 \text{ N/mm}^2$ ), and the recovery of the yield point elongation  $\sim 0.2\%$ . Because Nakaoka et al teaches substantially the same process as presently claimed, as well as a bake hardenability within the presently claimed range, Nakaoka et al is held to create a prima facie case of obviousness of the presently claimed invention.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (703) 308-4757. The examiner can normally be reached on 7:30 am- 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7719 for regular communications and (703) 305-7719 for After Final communications.

Application/Control Number: 09/508,490

Page 5

Art Unit: 1742

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script, appearing to read "G. Wyszomierski".

GEORGE WYSZOMIERSKI  
PRIMARY EXAMINER

jcm  
February 13, 2001